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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,753	03/10/2000	Ronald M. Evans	SALK1510-3	4924

7590 01/14/2003  
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EXAMINER

LOEB, BRONWEN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 01/14/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/522,753

Applicant(s)

EVANS ET AL.

Examiner

Bronwen M. Loeb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2002 and 09 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-5, 9, 10, 12-14, 16-25 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☒ Claim(s) 3-5, 9, 10, 12-14, 16, 17, 19-25 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 December 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The request filed on 1 November 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/522,753 is acceptable and a CPA has been established. An action on the CPA follows.

An amendment was filed 9 December 2002 in which claims 3-5, 9, 10, 12, 13, 14 and 16 were amended, claims 1, 2, 6-8, 11, 15 and 26-37 were cancelled and new claim 38 was submitted.

Claims 3-5, 9, 10, 12-14, 16-25 and 38 are pending.

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

There is no signature for Inventor Chan.

Applicant acknowledged the defective oath/declaration in the amendment filed 10 April 2002 and stated that this would be corrected under separate cover. To date, the corrected oath/declaration has not been received.

### ***Drawings***

2. The corrected or substitute drawings were received on 9 December 2002. These drawings are acceptable. It is noted however that substitute Figure 5A did not include

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Figure 5B, which was on the same page in the as-filed Figure 5, nor was a separate sheet with Figure 5B filed. If Applicant intends to delete Figure 5B from the application, this must be done explicitly and included deletion of all reference to Figure 5B in the specification. If Applicant intends to keep Figure 5B in the application, it should be filed on a separate sheet. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. Applicant's attention is also drawn to the attached Form 948, Draftsperson's Patent Drawings Review. Applicant is required to submit the drawings corrections within the time period set in this Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

### ***Claim Objections***

4. Claims 4, 5, 9, 12 and 14 are objected to because of the following informalities: Each of these claims recites the parenthetical phrase "(collectively, a SMRT co-repressor)" which is somewhat redundant as SMRT has already been defined in the claim. It is suggested that each be amended to recite: "An isolated polynucleotide encoding a SMRT co-repressor (silencing mediator of retinoic acid receptor and thyroid hormone receptor) or a peptide portion thereof or an isolated polynucleotide complementary thereto....." or the appropriate similar language. The claims dependent on these claims are thus objected to for the same reason. Appropriate correction is required.

***Response to Amendment***

5. The rejection of claims 1, 3, 5, 6, 8, 11 and 19-22 under 35 U.S.C. §112, first paragraph, for insufficient written description, has been withdrawn in view of Applicant's amendment.

The rejection of claims 4, 7, 9, 10 and 12 stand rejected under 35 U.S.C. §112, first paragraph, for insufficient written description, has been withdrawn in view of Applicant's amendment.

The rejection of claims 3, 5 and 16, and amended claim 14 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite, has been withdrawn in view of Applicant's amendment.

The rejection of claims 9, 10 rejected under 35 U.S.C. §112, second paragraph, as being indefinite, has been withdrawn in view of Applicant's amendment.

6. New grounds of rejection, necessitated by Applicant's amendment, are set forth below.

***New Grounds of Rejection***

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claim 18 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites dependency on claim 7 however claim 7 is cancelled. Thus the metes and bounds of claim 18 cannot be ascertained. Is the claim dependency supposed to be to claim 5?

### ***Conclusion***

Claims 3-5, 9, 10, 12-14, 16, 17, 19-25 and 38 are allowable if the objection to the independent claims is overcome. Claim 18 is rejected.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bronwen M. Loeb whose telephone number is (703) 605-1197. The examiner can normally be reached on Monday through Friday, from 11:00 AM to 7:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than the next business day after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached on (703) 305-1998.


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The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Bronwen M. Loeb, Ph.D.  
Patent Examiner  
Art Unit 1636

January 12, 2003



**JAMES KETTER  
PRIMARY EXAMINER**